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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,799	03/12/2004	Robert P. Cassoni	527.1003DIV	8292
23280	7590	05/19/2006	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			YEAGLEY, DANIEL S	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/799,799		CASSONI, ROBERT P.	
	Examiner		Art Unit	
	Daniel Yeagley		3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

D000ETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 14 – 33 are rejected under 35 U.S.C. 102(a) as being anticipated by St. Clair '257.

St. Clair shows a mountable device *for* a golf car (figure 1) comprising a frame *for* placement in a bag bay 12 of a golf car, a frame section 21 or 17 that contact a bottom of a bag bay and an attachment device 29 (figure 3) which contacts a bag holder frame 11 of the bag bay, and a first and second hitching device (left side 41, 44a, 47a, and right side 42, 44a, 47a) which are connected to the frame, such that hitch elements 41 and 42 at least partially extend downward from the frame section so as to at have a height similar to a bumper which at least partially extend downward over the bumper of the golf car and located side-by-side at the rear of the golf car (figure 1) and wherein the first hitching device includes one of a mount tube and a mount bracket which includes a claw ((lower bracket arm of 18, forming an L-shaped portion (claw)) and includes first and second driven (manually) actuators 22 that move the hitching devices, wherein a first and second detachable golf club carrier 14 have at least one wheel *for* contacting ground and a golf bag held by a holding device (figure 2, column 3, line 42-43), wherein the carriers are attachable to either one of the first and second hitching devices and capable of supporting the entire weight of the carrier when the wheel is off the ground when the hitching devices are moved with respect to a portion of the frame 24 as broadly claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hokaku et al '954 in view of Casady '746.

Mitsunobu discloses a mountable device having a frame comprising a frame section contacting a bottom of a bag bay and an attachment device that contacts a bag holder frame (figure 1-10), and includes a hitching device at the rear of the golf car that at least partially extend downward from the frame section over a bumper of the golf car, so as to at have a height similar to a bumper and is movable with respect to the frame by a driven actuator (figure 2-4, 6-8, 9-11), wherein the first hitching device includes one of a mount bracket having a claw 7 and a mount tube attachable to a detachable device (detachable golf club carrier 2) comprising a golf bag held by a holding device, wherein the detachable golf club carrier has at least one wheel and is supported by the hitch device when the wheel is off the ground, such that the golf club carrier is rotatable with respect to the frame to lift the wheel (figure 2-4) and the entire weight of the detachable device is supported by the hitch device as claimed and further discloses lifting a plurality of golf bags by the hitch device, but failed to show a second hitch device and detachable device.

Casady discloses the art of incorporating a plurality of hitching devices located side-by-side at the rear of the golf car (figure 1) to lift individual detachable devices.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mountable device of Mitsunobu and added additional hitching devices to the golf car of Mitsunobu capable of lifting a plurality of golf club carriers for additional individual detachable devices, as suggested by the individually lifted detachable golf club carriers of Casady, simple as an alternative known method of lifting individual detachable devices one at a time rather than a plurality of device all at once, in order to obtain access to only one detachable device at a time; if desired and to reduce the weight, stress and possible fatigue and failure to a hitch and lifting device lifting all the detachable devices at once.

5. Claims 27 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casady '746 in view of Tang '031.

Casady shows a mountable device for a golf car comprising first and second hitching devices 29, 30 connected to and movable with respect to a frame 11, the frame being connected to the golf car by at least one attachment device 14, the hitching device having one of a mount tube and bracket which includes a claw 29a and includes a first and second detachable devices being a golf bag carrier that includes a golf bag attached by holding means (top and bottom rings of carrier bag carrier), but failed to show the detachable carriers having at least one wheel for contacting the ground.

Tang shows a golf bag carrier (detachable device) having a golf bag 10 attached by holding means S that includes the feature of at least one wheel for contacting the ground.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified or replaced the golf bag carrier with a golf bag carrier having at least

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one wheel for contacting the ground as suggested by Tang as it is well known and clearly obvious to one of ordinary skill in the art to utilize wheels on a golf bag carrier in order to wheel the bag around instead of carrying the bag for less fatigue, safety and simply more convenient.

Response to Arguments

6. Applicant's arguments filed 2/27/06 have been fully considered but they are not persuasive. In response to applicant's argument that the golf bag of Casady would not be combinable with Tang, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tang discloses that prior art of applying at least one wheel for contacting the ground to a golf club bag carrier and the hitch of Casady supports the weight of the carriers by the pins 36 and 37 and the side wall 15 or 20 of the hitch and also the surface of the fender or well. Wherein the hitch does support the entire weight of the detachable device from the time the modified carrier wheel

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leaves the ground until the carrier rest in its final resting place. In response to applicant's argument that St Clair does not disclose a mountable device for a golf car and does not have a frame section contacting a bottom of a bag bay, a claw mount bracket, an attachment device contacting a bag holder frame and a hitch device extending over a bumper, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

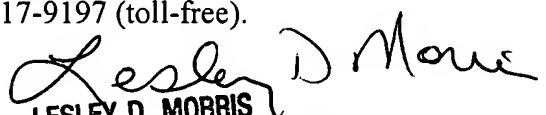
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Yeagley whose telephone number is (571)-272-6655. The examiner can normally be reached on Mon. - Fri; first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on (571) - 272 - 6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.Y.


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